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RATNER PRESTIA
P O BOX 980
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OFFICE OF PETITIONS

In re Application of
Pinchuk, et al. :
Application No. 09/657,041 :
Filing Date: 5 September, 2000 :
Attorney Docket No. BSI-430US8 :

This is a decision on the petition under ¶(a) of 37 C.F.R. §1.47, filed on 9 February, 2004.

The Office regrets the delay in addressing this matter. This matter was received by the Office of Petitions only at this writing.

The petition is **DISMISSED**.

NOTES:

- (1) Any reply must include a renewed petition (and fee) must include a petition under 37 C.F.R. §1.47 and must be submitted within two (2) months from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Petition under 37 C.F.R. §1.47";
- (2) Thereafter, there will be no further reconsideration of this matter.

BACKGROUND

The record indicates:

- the application was filed on 5 September, 2000, and, in the Office action of 2 July, 2003, the Examiner found that the re-issue application had been filed without, *inter alia*, a valid and fully executed oath or declaration because the oath/declaration filed failed “to identify at least one error which is relied upon to support the reissue application”; and
- a Supplemental Reissue Declaration filed with an amendment on (or about) 6 October, 2003 (over a 1 October, 2003, Certificate of Mailing), was unsigned and Petitioner’s reply filed on 11 December, 2003 (without a request and fee for extension of time), included and oath/declaration that was not a valid fully executed oath/declaration and no petition under 37 C.F.R §1.47) was filed at that time;
- therefore, the application appears to have gone abandoned after midnight 1 October, 2003;
- no Notice of Abandonment was mailed by the Office;
- the instant petition under 37 C.F.R §1.47 was filed via FAX on 9 February, 2004, after the instant application went abandoned, and was not accompanied by a petition (with fee) to revive the application as abandoned due to unintentional delay (under 37 C.F.R §1.137(b));
- the instant petition references, *inter alia*, an oath/declaration signed by named inventors save for Rysler Alcime (Mr. Alcime); and a declaration by Petitioner Jonathan H. Spadt (Reg. No. 45,122), and a copy of a letter from Petitioner to the non-signing inventor Mr. Alcime, however the copy of the letter to Mr. Alcime indicates that only the oath/declaration—and not the entire application (description, claims, drawings)—was sent to Mr. Alcime.

ANALYSIS

The regulations at 37 C.F.R. §1.47 provide in pertinent part:

§ 1.47 Filing when an inventor refuses to sign or cannot be reached.

(a) If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself or herself and the nonsigning inventor. The oath or declaration in such an application must be accompanied by a petition including

proof of the pertinent facts, the fee set forth in § 1.17(h), and the last known address of the nonsigning inventor. The nonsigning inventor may subsequently join in the application by filing an oath or declaration complying with §1.63.

* * *

The regulations at 37 C.F.R. §1.63 provide in pertinent part:

§1.63 Oath or declaration.

(b) In addition to meeting the requirements of paragraph (a) of this section, the oath or declaration must also:

- (1) Identify the application to which it is directed;
- (2) State that the person making the oath or declaration has reviewed and understands the contents of the application, including the claims, as amended by any amendment specifically referred to in the oath or declaration; and
- (3) State that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in § 1.56.

Thus, a copy of the entire application must be sent to the last known address of the non-signing inventor (or the estate representative) with a request that he/she sign the declaration for the patent application--and evidence of that transmittal submitted. (And a reasonable effort must be made to ascertain a current or last known address.)

Alternatively, an oath or declaration for the patent application in compliance with 37 C.F.R. §§1.63 and 1.64 must be presented.

The declaration must set forth the inventor's residence, citizenship and post office address. An oath or declaration in compliance with 37 C.F.R. §§1.63 and 1.64 signed by the Rule 1.47 applicant is required.¹

¹ See: MPEP 409.03(b).

CONCLUSION

Due to the abandoned status of the instant application and the failure to evidence the transmittal of the entire application to Mr. Alcime for his review before signing the oath/declaration and materials, this petition is not grantable at this writing.

A petition (with fee) under 37 C.F.R §1.137(b) is required to revive the application and the required reply is a grantable petition under 37 C.F.R §1.47

Therefore, the instant petition must be and hereby is dismissed.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents²
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX: (703) 872-9306 (IFW Formal Filings)
ATTN.: Office of Petitions

By hand: Mail Stop: Petition
Customer Service Window
Lobby/Room 1B03
Crystal Plaza Two
220 20th Street S.
Arlington, VA 22202

Telephone inquiries regarding this decision should be directed to the undersigned at (571) 272-3214.



John J. Gillon, Jr.
Senior Attorney
Office of Petitions

² To determine the appropriate addresses for other subject-specific correspondence, refer to the USPTO Web site at www.uspto.gov.